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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/288,757	04/08/1999	FRED L. HOROWITZ	991057	7857

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EXAMINER

RIMELL, SAMUEL G

ART UNIT

PAPER NUMBER

2175

DATE MAILED: 07/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/288,757

Applicant(s)

HOROWITZ ET AL.

Examiner

Sam Rimell

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

JAM RIMELL
PRIMARY EXAMINER
AC 2175

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Claims 1-12 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 calls for "input means" as well as "means associated with at least one computer for inputting". It is not clear what distinction, if any, exists between these two recited input means.

Claim 26 states "said step of providing access to participant data includes providing access to participant data". This statement is clearly redundant, as well as confusing.

Claim 27 states "said participant data includes data regarding said participants". This statement is clearly redundant, as well as confusing.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-3, 5, 7-9, 12, 13, 16, 19, 21, 24-27 are rejected under 35 U.S.C. 102(a) as being anticipated by Spurgeon ('129).

The reasons for this rejection were set forth in the office actions of 12/15/00 and 3/18/02 and are hereby incorporated by reference. With respect to newly added claims 26-27, no patentable weight is attributed to the redundant recitation of pre-existing claim language. The data can be accessed by any one of the multiple providers, such as illustrated in FIG 1.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10, 11, 14, 15, 20, 22 and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Sprugeon ('129).

The reasons for this rejection were set forth in the office action of 12/15/00 and are hereby incorporated by reference.

Claims 4, 6 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon ('129) in view of Moore et al. ('759).

The reasons for this rejection were set forth in the office action of 12/15/00 and are hereby incorporated by reference.

Remarks

Applicant's arguments submitted the CPA transmittal and amendment of June 5, 2002 have been considered but are not well taken.

Applicant has amended the specification to clarify the term "real time" and has relied upon a definition that appears to be a standard definition in the art. Since the definition provided in the specification is a standard definition, there are no issues raised by its insertion in the original specification.

However, examiner maintains that Sturgeon teaches "real time" processes, even according to the precise definition which applicant has provided. Within the claims, the term "real time" is associated with 2 different processes. These are:

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- (1) The determination of insurance coverage eligibility; and
- (2) The recordation of certain data pertaining to benefits utilized.

Examiner maintains that Sturgeon discloses these processes as being performed in real time, according the exact definition provided by applicant. Column 3, lines 42-47 describes an eligibility check which provides an immediate response to a query on insurance eligibility. This is clearly a "real time" process by applicant's own definition of the term, since the query is processed immediately and the data results returned to the physician provider immediately. There is no delay in processing or providing the data. In addition, the step of recording data at the processing terminals 16, 18, 28 or 32 also occurs immediately upon receipt at those terminals. There is no suggestion in Spurgeon that the data which has been directed to terminals (16, 18, 28 or 32) is diverted, delayed, placed in queue, placed in a cache, or otherwise delayed from its recordation within these processors. Once the data is actually pushed down to these terminals, the recordation process itself is not delayed or held up in any way. The recordation is an immediate process that takes place upon receipt of the data.

Applicant also argues that Spurgeon does not allow for multiple providers to access the data of one participant. This argument is not well taken. The quote provided in applicant's remarks (page 11, third paragraph of remarks) clearly illustrates two different providers accessing the exact same data. When a patient transfers to a different provider, the data is transferred to that new provider. In such a circumstance, clearly, two different providers have been able to access the patient's data. FIG 1 also clearly illustrates data sharing, where data from the same patient is shared among a primary provider and a specialist provider.

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Applicant further argues that the reference to Moore et al. is defective, since it does not teach the determination of patient eligibility prior to providing a procedure. However, this feature is already taught by Spurgeon (col. 3, lines 42-47). Moore et al. is relied upon for its teaching upon for its teaching of inputting specific types of data. Spurgeon already teaches the concept of eligibility determinations prior to a procedure, and Moore et al. is not required to re-teach the same feature.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (703) 306-5626.



Sam Rimell
Primary Examiner
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